

"Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

Applicants submit that the new grounds for rejection were not a result of amendment presented in response to the February 7, 2005.

First, applicants point out that claim 1 was amended in a Preliminary Amendment that pre-dates the Office Action. This Patent Application Information Retrieval system lists the Preliminary Amendment as having been received by the U.S. Patent Office on January 20, 2004 and the August 10, 2004 Office Action lists the claims added in the Preliminary Amendment. Therefore, the new rejection was not necessitated by the amendment of claim 1. Since any new grounds for rejection would result in the requirement of a non-final Action, this rejection alone requires that the finality be withdrawn.

Second, applicants point out that the amendment to claim 46 did not result in the new grounds for rejection of that claim. In this regard, please note that claim 46 has always been directed to an up-flow column reactor. Paragraph 14 of the final Action recognizes that the primary reference of the first Action, Brill US 3,192,184, shows a down flow reactor. Here, it is also noted that the new rejection against claim 46 is under 35 USC 102 and, thus, is not directly responsive to any amendment that was presented.

For the above reasons, it is submitted that the Action dated February 7, 2005 contained two new rejections that were not necessitated by amendments presented in response to the first Action and should have been issued as a non-final Action.

The Commissioner is hereby authorized to charge any fee deficiency or credit any additional charges to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

Respectfully submitted,

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